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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,092	09/24/2003	Jon C. Serbousek	DEP652CON	6297
27777	7590	06/04/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			MELSON, CANDICE C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/670,092	Applicant(s) SERBOUSEK ET AL. en	
	Examiner Candice C. Melson	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/24/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 10-23 of U.S. Patent No. 6,652,591. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between Claims 1-10 of the application and Claims 1-5 & 10-14 of the patent lies in the fact that the patent claims include more elements and is thus much more specific. Thus, the invention of Claims 1-5 & 10-14 is in effect a "species" of the "generic" invention of Claims

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1-10. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed.Cir. 1993). Since Claims 1-10 are anticipated by Claims 1-5 & 10-14 of the patent, they are not patentably distinct from Claims 1-5 & 10-14.

As to Claims 13-21 of the application, these Claims are not patentably distinct from Claims 15-23 of the patent because the range of the position of the surface features as stated in Claims 15 & 21 of the patent covers the specific value as stated in Claims 13 & 19 of the application. Thus, Claims 13-21 are anticipated by Claims 15-23 of patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1) Claims 1-7, 13-17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Brooker, Jr. (USPN 4,865,608). Brooker discloses a “femoral stem 10” which includes a

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“head 14” “onto which a spherical ball having a conical bore is fitted” (column 3, lines 64-66).

“Body 16 has a proximal surface portion 20 immediately adjacent head 14, and a distal surface portion 22. “A plurality of surface features 24 are formed in proximal surface portion 20, extending in a generally transverse relationship with longitudinal axis 12. In preferred embodiments of the invention, a plane projected from surface features 24 intersects longitudinal axis 12 at an angle A of approximately 60° to 80°, with the preferred angle of intersection being approximately 70°. This results in surface features 24 being oriented approximately perpendicularly to a line of force F which is transmitted from head 14 to body 16. This preferred orientation of surface features 24 provides for maximum resistance to force F and for optimal distribution of stresses to the surrounding bone tissue of the femur” (column 4, lines 3-15).

“FIG. 2 shows proximal medial surface 28 which has a plurality of longitudinal surface features 30 formed thereon”. “Surface features 30 are also dimensioned so as to readily accept the ingrowth of bony tissue to anchor the proximal portion of stem 10 firmly into position” (column 4, lines 41-46). With respect to Claims 9 and 16, FIG. 4 shows that “surface features 10 and 30” are ribbed protrusions with steps.

2) Claims 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by DeCarlo, Jr. et al. (USPN 6,436,148). DeCarlo, Jr. et al disclose a hip prosthesis “ having a plurality of bone engaging ribs 12” and “adapted for implantation into the medullary canal of the patient’s femur” (column 2, lines 55-58). “The stem 10 has a proximal portion 14 and medial portion 22”(column 3, lines 17-22). “Ribs 12 are shown on the medial portion” and “can vary so as to optimize fixation within dense cancellous bone, allow effective load transfer to the bone and minimize micromotion of the implant with respect to the bone” (column 3, lines 35-38). “It is understood

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that portions of the medial, lateral or groove surfaces can be textured so as to facilitate bone ingrowth. One of ordinary skill in the art will appreciate that the ribs 12 can be defined by various parameters. For example, an angle A formed by the medial surface 34 and the lateral surface 36 can vary from about five degrees to about 90 degrees” (column 3, lines 58-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claim 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooker, Jr (USPN 4,865,608) in view of Mittelmeier et al. (USPN 3,894,297). Brooker discloses the prostheses as stated in Claims 7 and 17. However, Brooker does not disclose at least a portion of the surface of the ribs having one of a surface roughness, a porous coating, or a bioceramic. Mittelmeier et al disclose a prosthesis with “ribs 2” which “are given the form of the threaded profile of a bone screw in order to permit the bone to grow thereinto in a satisfactory manner” (column 2, lines 33-35). Furthermore, “in order to increase the retention of the device in the bone, the support ribs of the shaft and of the acetabulum member may be coated with a ceramic material” (column 3, lines 20-23). Because the device is then implanted into the body, it is inherent that the ceramic material must be biocompatible. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the bioceramic material as

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taught by Mittelmeier et al in to the prosthesis disclosed by Brooker, Jr. in order to provide increased bone growth.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Melson whose telephone number is (703) 305-8128. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Candice C. Melson


KEVIN SHAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700